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EXAMINER	
REDDY, KARUNA P	

  

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RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex Parte* STEFAN KIRSCH, KARL-HEINZ SCHUMACHER, and  
ALEXANDER CENTNER

Appeal 2009-010566  
Application 10/579,096  
Technology Center 1700

Oral Hearing Held: January 21, 2010

Before ADRIENE L. HANLON, CHUNG K. PAK, and  
PETER F. KRATZ, *Administrative Patent Judges*.

APPEARANCES:

ON BEHALF OF THE APPELLANT:

HARRIS A. PITLICK, ESQUIRE  
Oblon, Spivak, McClelland, Maier & Neustadt, LLP  
1940 Duke Street  
Alexandria, Virginia 22314

1           The above-entitled matter came on for hearing Thursday, January 21,  
2   2009, commencing at 2:22 p.m., at the U.S. Patent and Trademark Office,  
3   600 Dulany Street, Alexandria, Virginia, before Todd Brown, a Notary  
4   Public.

5           THE USHER: Calendar No. 60, Appeal No. 2009-010566,  
6   Mr. Pitlick.

7           JUDGE HANLON: Good afternoon, Mr. Pitlick.

8           MR. PITLICK: Good afternoon.

9           JUDGE HANLON: If you have a business card, you can hand it to  
10   our reporter. You may begin when you're ready. You have 20 minutes.

11          MR. PITLICK: Okay. The claimed invention here is drawn to a  
12   method for enhancing at least one performance property of an aqueous  
13   polymer dispersion comprising at least one water soluble ionic compound,  
14   which comprises removing at least 50 percent of the ionic compound from  
15   the polymer dispersion and then adding at least one salt of a monoalkyl or  
16   dialkyl ester of a sulfonated dicarboxylic acid.

17          Just to point out, if it's not already clear, what we're adding back is  
18   also and certainly can be a water soluble ionic compound. So we're  
19   removing all of it, and then we're adding at least 50 percent back of one  
20   particular water soluble ionic compound.

21          A number of rejections have been withdrawn in view of an  
22   amendment we filed with the Appeal Brief, but all the remaining rejections  
23   are under Section 103. All rely primarily on Wood. Wood is discussed in  
24   our specification. Wood basically discloses that in such aqueous  
25   dispersions, polymer dispersions, which are used, for example, as adhesives  
26

1 such as pressure-sensitive adhesive, because of the presence of water, you  
2 get a whitening or clouding which is due to the presence of these water  
3 soluble ionic compounds. So what Wood does is he removes them.

4       However, when they're removed, there is a problem that the wetting  
5 suffers. And so you've got one advantage, but then you have a disadvantage.  
6 Well, our Applicants discovered that when you add -- let me go back. I  
7 misspoke. The claim says removing at least 50 percent of the water soluble  
8 ionic. You don't have to remove all of it. So to the extent I said before that  
9 you remove it, I only meant at least 50. Certainly, that includes 100, but  
10 removing at least 50 percent is sufficient.

11       At any rate, so our Applicants discovered that when you add back one  
12 particular salt, as we've recited in the claims, you get better wetting, which I  
13 suppose you can say is not unexpected because that's what the references,  
14 for example, the Actonel A-220, suggests. However, the unexpected result  
15 here is that you don't get water whitening. And this is clearly an unexpected  
16 result. And certainly the suggestion to add any such material back once the  
17 main reference, Wood, which is certainly the closest prior art, tells you that  
18 it's going to cause a problem, what our Applicants are doing, actually, is  
19 something that's being taught away by the prior art.

20       And that in a nutshell is our, let's say, our theory of patentability here.  
21 I think it's pretty straightforward. The Examiner has commented on some of  
22 the data in the specification, which I think has been adequately responded to  
23 in the Appeal Brief and the Reply Brief, so I won't go into it here unless you  
24 have specific questions.

1 But I'll just point out that the data that we have actually uses this  
2 Actonel A-220, which is a commercial product that's sold by the S & E. So  
3 we're right in the same ballpark, I think, as the prior art that the Examiner  
4 has cited. And we've shown, again, that, you know, by adding this stuff -- I  
5 call it stuff -- but it's the stuff that we're adding in the second step, again, we  
6 maintain this lack of whiteness or cloudiness, and yet we still get the  
7 increased wetting that was lost by removing the water soluble ionic  
8 compound in the first step.

9 JUDGE HANLON: Do you have any questions? Okay. No  
10 questions. Thank you.

11 Whereupon, the proceedings, at 2:27 p.m., were concluded.  
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